

REMARKS

Claims 2-4, 7-11, 13, 14 and 22 are canceled. Claims 1, 5, 6, 12, 15-21 and 23-35 are pending. Independent claims 1, 6 and 15 have been amended to overcome the rejections based on the prior art cited by the Examiner. No new matter was added. Applicants respectfully submit that the present application is in condition for allowance.

35 USC §102(b) Claim Rejections

In the Office Action, the Examiner rejected claims 1, 5, 6, 12, 16-21, 23-31 and 33-34 under 35 USC §102(b) as being anticipated by U.S. Patent No. 4,842,951 issued to Yamada et al..

The limitations previously stated in dependent claims 2 and 7 (now canceled) of the present application have been added into independent claims 1 and 6 (as amended) of the present application. The added limitations require the platelet filler to be high purity talc and require a CIE whiteness index of at least 40. No new matter was added.

The Yamada patent does not disclose the use of high purity talc nor does it disclose a CIE whiteness index of at least 40. The importance of the CIE whiteness index in relation to the purity of the talc is described in detail on page 6, lines 12-21, of the present application, as filed.

In the Office Action, the Examiner did not reject either of claims 2 and 7 as being anticipated by the Yamada patent.

Therefore, for the above stated reasons and for the same reasons that claims 2 and 7 were not previously rejected as being anticipated by the Yamada patent, Applicants respectfully submit that independent claims 1 and 6, and all claims depending therefrom, are patentable and not anticipated by the Yamada patent.

Accordingly, reconsideration and removal of the §102(b) rejection is requested.

35 USC §103(a) Claim Rejections

In the Office Action, the Examiner rejected claims 2, 7, 15, 32 and 35 under 35 USC §103(a) as being obvious over U.S. Patent No. 4,842,951 issued to Yamada et al. in view of U.K. Patent Application Publication No. GB 2295617 A of Branch (a named inventor of the present application).

The primary reference, the Yamada patent, discloses a laminate used to form containers for foods, beverages and medicines. It includes a gas permeation-resistant resin layer (22) sandwiched between a pair of talc-filled polyolefin based resin layers (23). Yamada discloses that the gas permeation-resistant resin layer (22) has a thickness of about 5 to 100 μm .

The Examiner admits that the Yamada patent fails to disclose the use of high purity talc having an aspect ratio of at least 5, an average aspect ratio of from 16 to 30, and a CIE whiteness of at least 40. Thus, the Examiner relies on the above cited GB reference for its disclosure of a platelet filler of high purity talc.

Independent claims 1, 6 and 15 of the present application have each been amended to require the talc-filled layer to contain from 5% to less than 30% by weight of talc. No new matter was added. See previous claim 22 (now canceled), and see claim 10 (previously canceled) of the present application, as filed.

Applicants respectfully submit that the Yamada patent “teaches away” from a talc-filled layer having a content of talc in the claimed range. The Court of Appeals for the Federal Circuit has held that a reference that “teaches away” from the claimed invention defeats any *prima facie* case of obviousness based on the reference. See In re Fine, 5

USPQ2d 1596 (Fed Cir 1988), In re Hedges, 228 USPQ 685 (Fed Cir 1986), and In re Nielson, 2 USPQ2d 1525 (Fed Cir 1987). In fact, a reference that “teaches away” from the claimed invention supports a finding of nonobviousness of the claimed invention.

The Yamada patent teaches on column 4, lines 20-37, that:

“... **it is essential** that the polyolefin based resin layer contains the inorganic filler in an amount of **30-80% by weight, preferably 35-70%** by weight. When the content of the inorganic filler is less than 30% by weight, not only heat resistance and mechanical strength are decreased but also the polyolefin based resin layer has a high heat of combustion which will include damages or disorder in incinerators.” [Emphasis added.]

As clearly taught by the Yamada patent, it is essential that the content of talc not be less than 30% by weight. The ideal talc content according to the Yamada patent, as taught by the Examples disclosed in the Yamada patent, is 60% by weight.

Accordingly, Applicants submit that the disclosure of the Yamada patent teaches one of ordinary skill in the art away from the use of less than 30% by weight of talc. Thus, one following the teachings of Yamada would avoid utilizing less than 30% by weight of talc. As such, the Yamada patent clearly “teaches away” from the claimed invention and cannot form the basis of a *prima facie* case of obviousness under 35 USC §103(a). Accordingly, the Yamada patent supports a holding of nonobviousness of the claimed invention.

For the above stated reasons, independent claims 1, 6 and 15, and all claims dependent therefrom, are patentable and nonobvious over the cited combination of the Yamada and UK references. In fact, the Yamada patent “teaches away” from the invention claimed in claims 1, 6 and 15 of the present application, and thus, actually supports a finding of nonobviousness.

Accordingly, reconsideration and removal of the §103(a) rejection is requested.

Conclusion

In view of the amendments and remarks, Applicants respectfully submit that the rejections have been overcome and that the present application is in condition for allowance. Thus, a favorable action on the merits is therefore requested.

Please charge any deficiency or credit any overpayment for entering this Amendment to our deposit account no. 08-3040.

Respectfully submitted,
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